



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,815	06/04/2001	Egidio Lavorgna JR.	60709-00017	4578

7590

03/24/2005

John S. Beulick
Armstrong Teasdale LLP
Suite 2600
One Metropolitan Sq.
St. Louis, MO 63102

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/873,815

Applicant(s)

LAVORGNA ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/18/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 1/18/02 was filed after the mailing date of the application on 6/4/01. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Dependent claims 15-18 are objected because they further limit claims which are named after them (claims 17-19).

Dependent claims 20-25 are objected because they further limit claims which are named after them (claims 24-30).

Misnumbered claims 37 and 38 been renumbered 38 and 39. There are 2 (No. 37) claims in the original document.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-13, 19-25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-13 are directed to “A method for management of business metrics using a system”, which is not within one of the classes of invention set forth in § 101.

The “A method for management of business metrics using a system” comprising the step of:

(a) providing user with a web interface ... by the user, as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The “method for management of business metrics using a system” comprising the step (a) as shown is:

- 1) merely an abstract idea and
- 2) does not reduce to a practical application in the technological arts (integration with computer/ computer network to produce an output result) and are therefore are found to be non-statutory.

In the present case, claims 19-25 are directed to “A method for providing business management with business metrics”, which is not within one of the classes of invention set forth in § 101.

The “A method for providing business management with business metrics”
comprising the step of:

(a) creating ... ;

(b) entering ... ;

(c) uploading ... ; and

(d) providing ... management”, as shown are merely an abstract idea and do not
produce a useful, tangible, concrete results.

The “method for providing business management with business metrics”
comprising the step (a) – (d) as shown are:

1) merely an abstract idea and

2) does not reduce to a practical application in the technological arts (integration
with computer/ computer network to produce an output result) and are therefore are
found to be non-statutory.

See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173
USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re*
Johnston, 183 USPQ 172.

Claim Rejections - 35 USC § 112

5. Claims 1-13, 14-18, 19-25, 26-29, 30-33, 34-37, 38-39 are rejected under 35
U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The
“Background of the Invention”, Part [0003] discloses the 4 steps (or tools) of “ (1)
capturing, (2) analyzing, (3) reporting and (4) assessing business metrics can be a
highly valued business management tool” which are critical or essential to the practice

Art Unit: 3629

of the invention “managing business metrics”, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

6. Claims 1-12, 14-18, 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and confused because it's not clear whether the “web interface” on line 3 and 4 and the same or different.

Claims 1-13, 19-25 call for “a method for management of business metrics” but the only step of “providing user with a web interface configurable to a template accommodating business metrics data by the user” fails to show how the managing is carried out. Part [0003] disclosing the steps of “capturing, analyzing, reporting and assessing business metrics can be a highly valued business management tool”. These steps are not in the claim.

Claims 14-18 call for “a business metrics management system” but there are no elements dealing with managing the metrics. Part [0003] disclosing the four critical tools “capturing, analyzing, reporting and assessing business metrics can be a highly valued business management tool”. These tools are not in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3629

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 38-39 are rejected under 35 U.S.C. 102(e) as being anticipated by DAUDENARDE.

As for indep. claim 38, DAUDENARDE discloses a database {see Fig. 1, 118-124} comprising metrics data obtained from a template {see Fig. 2, 212 (template) and Data (202), (206), [0052, 0057, 0064]}.

As for dep. claim 39, which deal with relational data, this is taught in [0010 "relational database"].

9. Claims 34-37 are rejected under 35 U.S.C. 102(e) as being anticipated by DAUDENARDE.

As for indep. claim 34, DAUDENARDE discloses a computer-readable medium executable by a computer connected to a user device, for controlling the computer to :

- (a) receive a request to provide a web interface;
- (b) provide a web interface configurable to a template;
- (c) receive business metrics data in the template;
- (d) store the template {see Figs. 1, 2, 14,,15, [0040, 0044, 0057, 0058]}.

As for dep. claim 35, this is inherently included in [0044] which deal with interface with the Internet protocol and the transmission language thereof.

As for dep. claim 36, this is taught in Figs. 1 and 2.

Art Unit: 3629

As for dep. claim 37, this is taught in [0052, last 2 lines].

10. Claims 30-33 are rejected under 35 U.S.C. 102(e) as being anticipated by DAUDENARDE.

As for indep. claim 30, DAUDENARDE discloses an apparatus comprising :

- (a) means for providing a web interface to a user;
- (b) means for configuring the web interface to a template;
- (c) means for entering business metrics data in the template;
- (d) means for storing the template {see Figs. 1, 2, 14, 15, [0040, 0044, 0057, 0058]}.

As for dep. claim 31, this is inherently included in [0044] which deal with interface with the Internet protocol and the transmission language thereof.

As for dep. claim 32, this is taught in Figs. 1 and 2.

As for dep. claim 33, this is taught in [0052, last 2 lines].

11. Claims 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by DAUDENARDE.

As for indep. claim 26, DAUDENARDE discloses an apparatus comprising :

- (a) computer,
- (b) server configured with a database enabled for storing and retrieving a template, the server additionally configured to upload and store business metrics data in a database;

(c) a network communicative with the server and a user device connected to the network {see Figs. 1, 2, 14, 15, [0040, 0044, 0057, 0058]}.

As for dep. claim 27, this is inherently included in [0044] which deal with interface with the Internet protocol and the transmission language thereof.

As for dep. claim 28, this is taught in Figs. 1 and 2.

As for dep. claim 29, this is taught in [0052, last 2 lines].

12. Claims 14-18 are rejected under 35 U.S.C. 102(e) as being anticipated by DAUDENARDE.

As for indep. claim 14, DAUDENARDE discloses an apparatus comprising :

(a) computer,

(b) server configured with a database enabled for storing and retrieving a template, the server additionally configured to upload and store user input regarding business metrics in a database;

(c) a network communicative with the server and a user device connected to the network {see Figs. 1, 2, 14, 15, [0040, 0044, 0057, 0058]}.

As for dep. claims 15-16, these are taught in [0043-0046].

As for dep. claims 17-18, these are taught in [0057-0059].

13. Claims 1-13 are rejected under 35 U.S.C. 102(e) as being anticipated by DAUDENARDE.

As for indep. claim 1, DAUDENARDE discloses a method comprising:

(a) provide user with a web interface configurable to a template accommodating business metrics data by the user, {see Figs. 1, 2, 14, [0040, 0044, 0057, 0058]}.

Art Unit: 3629

As for dep. claims 2-4, these are taught in [Figs. 1, 13-14, 0057-0058].

As for dep. claims 5-6, these are taught in [Figs. 3, 4, 5].

As for dep. claims 7-8, these are taught in [Figs. 2,3, 0052-0053].

As for dep. claims 9-11, these are taught in [0057-0060].

As for dep. claims 12-13, these are taught in [0057-0060].

14. Claims 19-25 are rejected under 35 U.S.C. 102(e) as being anticipated by DAUDENARDE.

As for indep. claim 19, DAUDENARDE discloses a method for providing business management with business metrics comprising :

(a) creating a business metric template;

(b) entering data into the template;

(c) uploading the template;

(d) providing the template to business management {see Figs. 1, 2, 14, 15, [0040, 0044, 0057, 0058]}.

As for dep. claim 20-21, these are taught in [0057-0060].

As for dep. claims 22-25 which are similar to dep. claims 8-11 above, they are rejected for the same reasons set forth in dep. claims 8-11 above.

No claims are allowed.

Art Unit: 3629

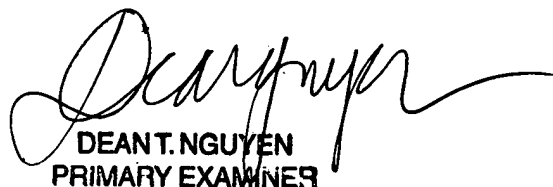
15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 or (571) 272-6806 (by April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
March 21, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER